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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Emissive Energy Corporation

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Serial No. 78358172

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Mark E. Tetreault of Barlow, Josephs & Holmes, Ltd., for Emissive Energy Corporation.

Paula B. Mays, Trademark Examining Attorney, Law Office 106 (Mary Sparrow, Managing Attorney).

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Before Hohein, Hairston, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On January 27, 2004, applicant Emissive Energy Corporation filed an intent-to-use application (No. 78358172) to register on the Principal Register (in standard character form) the term:

T1

for "flashlights, namely, hand held portable flashlights having light emitting diode lighting elements" in Class 11.

The examining attorney has refused to register applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), because of Registration No. 2,368,261, issued April 25, 2000, for the mark (in standard character form):

T-1

for "industrial, commercial, and residential lighting and signage applications, namely, electric fluorescent lamps, electric light fixtures and retrofit kits composed of electric fluorescent lamps" in Class 11. As to such registration, affidavits under Sections 8 and 15 have been respectively accepted and acknowledged.

The examining attorney made her refusal final in an Office action dated June 28, 2005. On November 1, 2005, applicant filed its notice of appeal and on November 9, 2005, it filed its appeal brief. In its appeal brief, applicant requested reconsideration of the final refusal. On December 12, 2005, the examining attorney denied applicant's request for reconsideration, and on December 29, 2005, the examining attorney filed her brief.[1]

[1] Inasmuch as the examining attorney denied the request for reconsideration and the evidence in applicant's appeal brief was of record at that time, we will consider that evidence. TBMP § 1204 (2d ed. rev. 2004) ("During the period between issuance of a final action and expiration of the time for filing an appeal therefrom, an applicant may file a request for reconsideration, with or without an amendment and/or new evidence").

The examining attorney points out (Brief at 7) that the "marks in this case are virtually identical. The only distinction is a hyphen in the registrant's mark." Also, the examining attorney argues that "both parties offer lighting related goods. Specification as to the type of electric lighting offered by the applicant may be good for product sales, but such specificity does not overcome the likelihood of confusion between marks. Furthermore, the fact that the goods of the parties may differ slightly is not controlling in determining likelihood of confusion." Brief at 8.

Applicant responds by arguing (Brief at 5) that:

> The Registrant has claimed only electric fluorescent lighting fixtures. This is a clear indication of the channel of trade. This is a designation for a manufacturer of lighting fixtures that require that the fixture typically be permanently mounted and a high voltage (120 or 277 volts) be made thereto. On the other hand, the Applicant has very narrowly defined their goods as hand held LED flashlights. This is also a very narrowly defined market segment. End consumers typically comprise military personnel, police and people in need of a light source when participating in outdoor activities. People seeking to purchase permanently mounted electric fluorescent lighting fixtures and those looking for a high performance portable flashlight are not even remotely similar customers.

Applicant included a page, apparently from registrant's website, that refers to its goods as follows:

> T-1® LIGHTING

> T-1 Lighting has developed a line of lighting products utilizing our patented T-1® light source. The T-1 is a minimal profile, long life, cold cathode lamp that produces bright, color correct light. Through these patented designs and proprietary technology, we have adapted the T-1 to create an extraordinary group of products tailored to the specifier, architect, distributor and end user.

As a result of this webpage, applicant maintains that "it is absolutely clear and incontrovertible that the T-1 in the Registrant's mark is intended only to be a model or grade designation for the type and size of fluorescent lamp that they use in their electric light fixtures." Brief at 3. Regarding its own mark, applicant maintains (Brief at 4) that "T1 does not indicate any particular model, component, lamp, grade or level of a flashlight, it is simply utilized to differentiate the Applicant's line of flashlights from others selling competitive flashlights."

When there is a question of likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to

the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

First, we consider whether the marks are similar. We compare their similarities in sound, appearance, meaning, and commercial impression. It is clear that these mark, T1 and T-1, are virtually identical. The only difference between the marks is the presence of the hyphen in registrant's mark. This punctuation mark would not distinguish the marks. In re General Electric Co., 180 USPQ 542, 544 (TTAB 1973) ("Notwithstanding the hyphen in applicant's mark, it is fair to assume that applicant's insulating material would ordinarily be called for and referred to by the designation 'REX.' Accordingly, it is concluded that the resemblances between the marks 'BRAND REX' and 'RE-X' are such as to be reasonably likely to cause persons to ascribe a common origin to the products sold thereunder"). Therefore, the appearance, pronunciation, meaning, and commercial impressions of the mark would be virtually the same.

Applicant argues that registrant's mark is a model or grade designation and, therefore, it "does not serve to distinguish the goods of the Registrant from the goods of

others." Brief at 3. Model or grade designations are not necessarily inherently distinctive. Neapco Inc. v. Dana Corp., 12 USPQ2d 1746, 1748 (TTAB 1989) ("Neapco assumes that because the registered mark 5-280X serves as a model or part number, that therefore it must automatically be considered merely descriptive. Such a conclusion would be appropriate if registrant's alphanumeric designation was used *merely* as a model or part number"). However, even if registrant's mark is such a designation, applicant's argument amounts to an impermissible collateral attack on the validity of the cited registration.

> Dixie's argument that DELTA is not actually used in connection with restaurant services amounts to a thinly-veiled collateral attack on the validity of the registration. It is true that a prima facie presumption of validity may be rebutted. See Dan Robbins & Assocs., Inc. v. Questor Corp., 599 F.2d 1009, 1014, 202 USPQ 100, 105 (CCPA 1979). However, the present ex parte proceeding is not the proper forum for such a challenge. Id. ("One seeking cancellation must rebut [the prima facie] presumption by a preponderance of the evidence."); Cosmetically Yours, Inc. v. Clairol Inc., 424 F.2d 1385, 1387, 165 USPQ 515, 517 (CCPA 1970); TMEP Section 1207.01(c)(v) (1993); 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* Section 23.24[1] [c] (3d ed. 1996). In fact, Cosmetically Yours held that "it is not open to an applicant to prove abandonment of [a] registered mark" in an ex parte registration proceeding; thus, the "appellant's argument … that [a registrant] no longer uses the registered mark … must be disregarded." 424 F.2d at 1387,165 USPQ at 517; cf. In re Calgon Corp., 435 F.2d 596, 598, 168 USPQ 278, 280 (CCPA 1971) (applicant's argument that its use antedated a registered mark was effectively an improper collateral attack on the validity of the

> registration, which should have been made in formal cancellation proceedings).
>
> Dixie claims that it is not arguing that the DELTA mark has been abandoned, only that it has not been used for restaurant services, so there is no likelihood of confusion. However, unless it establishes abandonment, the registration is valid, and we must give effect to its identification of services. Cosmetically Yours, 424 F.2d at 1387, 165 USPQ at 517 ("As long as the registration relied upon … remains uncanceled, it is treated as valid and entitled to the statutory presumptions.").

In re Dixie Restaurants, 105 F.3d 1405, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997).

In addition, we add that the single webpage that applicant submitted of registrant's use hardly demonstrates that registrant uses its mark in the nature of a grade designation. Therefore, even if applicant were limiting its argument to one that simply maintains that, because the registered mark is a model designation, it is not arbitrary, the evidence provides little support for this position.

Next, we must determine whether the goods of applicant and registrant are related. Applicant's goods are flashlights having LED elements. Registrant's goods are electric fluorescent lamps, electric light fixtures, and retrofit kits composed of electric fluorescent lamps. When we view the goods, we must base our conclusion of relatedness on how the goods are identified in the

application and registration. Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"). The examining attorney argues that the goods "are very closely related" (Brief at 7) and that "both parties offer lighting related goods." While we agree that flashlights and lamps and light fixtures provide light, we are unaware of any per se rule that holds that all lighting products are related. Furthermore, flashlights and electric fluorescent lamps, electric light fixtures and retrofit kits composed of electric fluorescent lamps do not appear to be complementary items that are used or purchased together. See In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991):

> In this case we have women's shoes, on the one hand, and women's pants, blouses, shorts and jackets, on the other. Despite applicant's argument to the contrary, we believe that these goods are related. A woman's ensemble, which may consist of a coordinated set of pants, a blouse and a jacket, is incomplete without a pair of shoes which match or contrast therewith. Such goods are frequently purchased in a single shopping expedition. When shopping for shoes, a purchaser is usually looking for a shoe style or color to wear with a particular outfit. The items sold by applicant and registrant are considered to be complementary goods. They may be found in the same stores, albeit in different departments. We are convinced that this is a sufficient relationship between the goods to support a holding of likelihood of confusion where both sets of goods are sold under the same mark.

Indeed, we have no evidence in this case that flashlights and fluorescent lamps and electric light fixtures are associated with a common source. We also have no evidence that prospective purchasers are likely to encounter these items in such a manner that they would assume that there is a relationship between their sources. The simple fact that both applicant's and registrant's goods are used to provide light is not enough, by itself, to show that the goods are related.

Therefore, even when we take into consideration that the marks are virtually identical and there is no evidence that the registered mark is weak, because of the lack of evidence that the goods are related, we hold that there is no likelihood of confusion in this case.

Decision: The refusal to register is reversed.